

REMARKS

Reconsideration of this application in light of the above amendments is courteously solicited.

Applicants have cancelled claims 11-25 which have been restricted out of the instant application. Applicants will file a divisional application on claims 11-25.

Initially, it should be pointed out that both the Monque et al. and Martinez et al. references are assigned to the assignee of the present invention.

The Examiner rejected previously submitted claims 1-10 under 35 U.S.C. 103. Applicants transverse this rejection.

The Examiner's attention is drawn to the examples as set forth in the specification of the instant application. The examples clearly set forth the advantages obtained with regard to the catalyst of the present invention as compared to the prior art teachings of the Monque et al. '256 patent. In this regard, see for example, Example 6 starting on Page 26 of the instant specification. The examples clearly demonstrate that the catalyst of the present invention provides excellent hydrodesulfurization activity and exhibits high tolerance to the presence of nitrogen while providing excellent HDN and HDO activity. The catalyst of the present invention does not have an adverse impact on octane values which is experienced when utilizing conventional hydrotreating catalysts known in the

prior art. In this regard the Examiner's attention is drawn to Pages 15+ of the instant specification.

The Examiner's conclusion of obviousness as set forth in his rejection is without merit. The Examiner's combination of the references amount to nothing more than a hindsight reconstruction in light of Applicant's instant disclosure and claimed subject matter.

The case law on the need for a motivation statement to support the combination of two prior art references is quite clear where an Examiner as in the instant case alleges that all of the claim limitations can be found in the prior art references. Assuming arguendo, that each limitation in each claim of the instant application could somewhere be found in Monque et al. or Martinez et al., more is needed. As noted in In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998), most if not all inventions arise from a combination of old elements. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir.

1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 173 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or implicit showing of motivation, the Examiner must provide particular findings related thereto. Id. Broad conclusory statements standing alone are not evidence of obviousness. Id. In the instant application, the Examiner has presented no clear statement stemming from the references or elsewhere as to what would motivate, suggest or teach the combination of references. Thus, having failed to make a proper obviousness rejection, the claims as amended should now be allowed.

In light of the foregoing, it is respectfully submitted that all of the claims as pending patentably define over the art of record and an early indication of same is respectfully requested.

An earnest and thorough attempt has been made by the undersigned to resolve the outstanding issues in this case and place same in condition for allowance. If the Examiner has any questions or feels that a telephone or personal interview would

be helpful in resolving any outstanding issues which remain in this application after consideration of this amendment, the Examiner is courteously invited to telephone the undersigned and the same would be gratefully appreciated.

It is submitted that the claims as amended herein patentably define over the art relied on by the Examiner and early allowance of same is courteously solicited.

If any fees are required in connection with this case, it is respectfully requested that they be charged to Deposit Account No. 02-0184.

Respectfully submitted,

Jorge Tejada et al.

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Version with markings to show changes made to the claim

1. (Amended) A hydroconversion catalyst for hydrodesulfurizing feedstock while preserving octane number of said feedstock, comprising:

a support comprising a mixture of zeolite and alumina, wherein said support comprises between about 10 and about 90% wt of said zeolite and between about 90 and about 10% wt of said alumina, said zeolite is MFI zeolite having an Si/Al ratio of between about 1 and about 20;

a metal active phase on said support and comprising a first metal selected from group 6 of the periodic table of elements, a second metal selected from the group consisting of group 8, group 9 and group 10 of the period table of elements, and a third element selected from group 15 of the periodic table of elements, wherein said metal active phase contains at least about 1% (wt) of said first metal, at least about 0.5% (wt) of said second metal, and at least about 0.2 % (wt) of said third element.